

Application No. 10/009,147  
Applicants: Peter Himmelsbach et al.  
Amendment in Response to Office Action dated July 10, 2003

#### REMARKS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

Claims 2-28 are pending. Amendments have been made to claims 2-14 in response to rejections under 35 U.S.C. 112, second paragraph, and to correct dependency issues. Claim 1 has been canceled in favor of new claim 15 for sake of clarity. New claims 15-28 have been added in response to the rejections under 35 U.S.C. 112, second paragraph. A mark-up showing the changes that have been made to these claims using strikethrough and underlining is presented above. It is believed that no new matter has been added.

#### Rejections under 35 U.S.C. 112, first paragraph

The Examiner found the specification failed to meet the requirements under 35 U.S.C. 112, first paragraph, wherein the specification is to be written in "full, clear, concise, and exact terms". The Examiner found (1) the term "pressure sensitively adhesively" to be informal; (2) the terms "pressure sensitive adhesive", "self-adhesive", and "cold seal" to be used interchangeably to define the present invention and thus confusing; (3) the terms "main claim" and "the subclaims" to be informal; (4) the description of the "backing material A" and "backing material B" to be essentially duplicates; and (5) the units to be missing from the numeric values in the ingredients in Examples 2-5.

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In response to all of the Examiner's points, Applicants will revise the specification if the Examiner insists. However, Applicants point out that the Examiner quotes only a portion of 35 USC § 112, first paragraph, and the pertinent portion actually reads: "... in such full, clear, concise, and exact terms as to enable any person skilled in the art ... to make and use the [invention]." Although the Examiner has pointed to some grammatical defects in the application, the Examiner has not explained how these defects would have prevented a person skilled in the art from being enabled to make and use the invention. Applicants submit that, the grammatical defects aside, the instant specification would be perfectly understood by any person having ordinary skill in the art, and such persons would have had no difficulty whatsoever practicing the full scope of the present invention. In short, Applicants do not believe that the specification is in any manner lacking compliance with 35 USC § 112, first paragraph. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

Rejections under 35 U.S.C. 112, second paragraph

Claims 1-14 stand rejected under 35 U.S.C. 112, second paragraph as being indefinite. In response, Applicants have canceled claim 1 and recast it as new claim 15 to recite a combination comprising a backing material and a latex-free cold seal composition. New claim 15 also makes it clear that the cold seal composition is a pressures sensitive adhesive. A definition for " $\tan \delta$ " is now provided in new claim 15. Support is found at page 6, lines 2931 of the instant specification. Applicants point out subject matter found in "especially", "preferably" and "preference" clauses have been made the subject of new dependent claim claims 16-27. New claim 28 is new claim 15 cast with a slightly different wording for clause iv), which wording

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derives from the specification at page 1, lines 13-15. Again, Applicants do not believe the changes to the claims introduce any new matter.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

#### Rejections under 35 U.S.C. 103

The Examiner rejected claims 1-14 under 35 U.S.C. 103(a) as being obvious over EP 0826380A2 combined with DE 19631422, or EP 0885942A1 as combined with statements made at page 2, 4<sup>th</sup> paragraph of the instant specification, each taken individually or in view of statements made at page 1, 2<sup>nd</sup> paragraph of the instant specification. The Examiner found each of the primary references to teach an adhesive composition based block copolymers of the A-B or A-B-A type. The Examiner alleged the Applicants have admitted EP 0885942A1 to disclose the block copolymers and the contemplated styrene content. The Examiner also found the use of ingredients such as tackifiers and additives to be well-known in the art, and each of the references to teach, or as allegedly admitted by the Applicants, the ingredients to be capable of being bonded to the skin in order to secure an article for a desired amount of time. Ultimately, the Examiner found if the parameters were not inherently disclosed, then it would have been obvious to optimize the parameters to obtain the present invention.

Alternatively, the Examiner alleges at page 5 of the Office Action that Applicants have

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admitted the claimed invention "except for the presence of a suitable cold seal composition based on the parameters set forth in Applicants' claim 1" wherein the cold seal composition is based on natural rubber. The Examiner found it would have been obvious to employ the adhesive compositions in each of the cited references to obtain the present invention.

In response, as to the alleged admissions, Applicants respectfully submit that no such admission was made, and, if the Examiner disagrees, Applicants respectfully requests that the Examiner point to page and line number where such admissions are seen.

Applicants would also point out that as should be clear from the very first paragraph of the instant specification, the object of the present invention was to provide a medical product that ***would stick to itself, but not substantially to other substrates, such as skin***, hair or clothes. By taking the position in the sentence bridging pages 4-5 of the Office Action that the prior art teaches and suggests the ingredients to be capable of ***being bonded to the skin*** in order to secure an article for a desired amount of time, the Examiner concedes what is, in fact, true: The prior art teaches away from the present invention.

Applicants also believe the requisite motivation is missing from each of the cited references, even though the Examiner believes otherwise. For purposes of evaluating the cited prior art references, Applicants have reviewed U.S. 2001/0051482 A1 which is believed to be an English-language equivalent of both EP 0826380A2 and DE 19631422. Applicants submit there is no suggestion or motivation in either EP 0826380A2 or DE 19631422 for the present

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combination, because the adhesive composition in the prior art does not exhibit cohesive properties as evidenced by the measured value of  $\tan \delta$ . The mere fact that references can be combined or modified, which Applicants do not concede here, does not render the resulting combination obvious unless the prior art also suggests the desirability of the combination. See *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990). The combination of cited references contains no suggestion to use a cold seal composition in the known backing materials, and does not suggest any specific benefit to be gained by such use, and certainly not the advantages that Applicants have disclosed and proven in the instant specification.

Even if the Examiner is correct in his allegations that a person skilled in the art would have been motivated to combine the prior art teachings, this would have only established a *prima facie* case of obviousness. However, Applicants refer the Examiner to paragraph 29 and the accompanying table at page 2 of the U.S. publication, wherein a higher value for  $\tan \delta$  and thus higher tack is disclosed, deficiencies that the present invention overcomes. A comparison of the table found in at page 2 of the U.S. publication and the table disclosed at page 7 of the instant specification show a tack value in the present invention that is at least 4 times less than the values seen in the cited prior art. Thus, the present invention provides a clear advantage in showing the cohesive properties as evidenced by the low tack values. There is nothing in the combination of the cited references that would have suggested these results. Accordingly, these data must be regarded as surprising, and, therefore, unexpected, and, consequently, as objective evidence of nonobviousness. Although these data are not in declaration form, consistent with the rule that *all* evidence of nonobviousness must be considered when assessing

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patentability, the Examiner must consider data in the specification in determining whether the claimed invention provides unexpected results. *In re Soni*, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995). Accordingly, Applicants submit the solution offered by the present invention is unexpected and therefore nonobvious.

Referring to EP 0885942A1, Applicants submit there is no motivation in the reference for the present invention, because there is nothing to suggest the present invention to have a bond strength to itself of "not less than 10 cN/cm". EP 0885942A1 at Tables 1 and 2 discloses data for an article having an adhesive applied thereon relating to "peel adhesion" to steel, textile and skin. The good adhesion to skin touted by the reference conflicts with the properties required by the instant invention, wherein the inventive product sticks to itself but exhibits substantially no adhesion to skin, hair or clothes. There is absolutely nothing in this reference or in its combination with the other cited references which teaches or suggests this property, which is demonstrated in the instant specification. It is worth repeating that the mere fact that references can be combined or modified, which Applicants do not concede here, does not render the resulting combination obvious unless the prior art also suggests the desirability of the combination. See *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990). Applicants refer the Examiner to Example 1 in the instant specification, wherein a bond strength of 0.6 N/cm of the combination to itself was measured, **and no sticking to the skin** was observed. Examples 2 through 5 similarly comprise measured bond strength values. Nowhere in EP 0885942A1, either alone or combination, is there any motivation for the article to have a bond strength to itself, but also substantially no bond strength to skin. Accordingly, Applicants submit the claims are not

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rendered obvious by the cited reference, either alone or in combination.

As to the Examiner's position that the claimed parameters are inherently present, if the Examiner relies on a theory of inherency as to any particular element, Applicants point out the extrinsic evidence must make clear that such element is *necessarily* present in the thing described in the reference, and the presence of such element therein would be so recognized by persons skilled in the art. *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Applicants submit the Examiner has not discharged this burden. Clearly, the properties required by the instant invention cannot be considered inherent in the cited prior art, as EP 0 885 942 A1 expressly teaches that the combinations described therein have different properties.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

#### Conclusion

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be

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promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 and the accompanying Petition for Extension of Time (19 pages total) are being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: December 10, 2003

By

Kurt G. Briscoe